



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

KANESAKA BERNER AND PARTNERS
PATENT AGENTS, LLP
1700 DIAGONAL ROAD, SUITE 310
ALEXANDRIA, VA 22314

COPY MAILED

APR 17 2006

OFFICE OF PETITIONS

In re Application of :
Mikio Nezu :
Application No. 10/804,074 :
Filed: March 19, 2004 :
Attorney Docket No. D-1569 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed February 24, 2006, to revive the above-identified application.

The petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)."

This application became abandoned for failure to timely reply to the non-final Office action mailed May 3, 2005. Accordingly, this application became abandoned on August 4, 2005. A Notice of Abandonment was mailed on December 5, 2005.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

- (1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;
- (2) The petition fee as set forth in § 1.17(l);
- (3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

This petition lacks items (1) and (3), above.

Decisions on reviving abandoned applications on the basis of “unavoidable” delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word ‘unavoidable’ . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullah, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a “case-by-case basis, taking all the facts and circumstances into account.” Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was “unavoidable.” Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

As to item (1):

The required reply has not been submitted. As such, the petition must be dismissed.

As to item (3):

Petitioner states, in pertinent part:

“I established a new Office of Hauptman Kanesaka Berner Patent Agents LLP on May, 2004 at 1700 Diagonal Road, Alexandria, VA 22314. The firm name was changed to Kanesaka Berner and Partners Patent Agents, LLP on October 2005 at the same address, i.e. 1700 Diagonal Road, Alexandria, VA 22314.

“After I moved to the new address, I asked the office manager to change the address of all my files acting as a principle agent. The office manager contacted the Electronic Business Center of the Patent Office and obtained an electronic list in which I was present on the declaration at the time of filing the application. The address of the files was changed according to the list provided by the Patent Office.

"However, the present application was not included in the electronic list supplied by the Patent Office. Accordingly, the Office Action and the Notice of Abandonment were not delivered to me.

"As stated above, I changed the address of all the files under the supervision of the Office manager. However, since the list obtained from the Patent Office did not contain the present case, the address of the present application was not inadvertently changed at the Patent Office."

Please note MPEP 601.03: "Where an attorney or agent of record (or applicant, if he or she is prosecuting the application pro se) changes his or her correspondence address, he or she is responsible for promptly notifying the U.S. Patent and Trademark Office of the new correspondence address (including ZIP Code)."

Furthermore, a delay caused by the failure on the part of petitioner, or petitioner's representative, to provide the Patent and Trademark Office with a current correspondence address does not constitute an unavoidable delay. See *Ray v. Lehman*, 55 F.3d 606, 34 USPQ2d 1786 (Fed. Cir. 1995).

As such, the burden and responsibility lies with petitioner to timely file a change of correspondence address with the Office. A reasonably prudent person in relation to their most important business would have confirmed any correspondence address data with their own docket records and files in order to assure the timely submission of a change of correspondence address with the Office.

Accordingly, the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).

Petitioner should consider filing a petition under 37 CFR 1.137(b).

The \$500.00 petition fee under 37 CFR 1.17(l) will be charged to deposit account no. 11-0219.

Further correspondence with respect to this matter should be addressed as follows:

By mail: **Mail Stop Petition
Commissioner for Patents
Box 1450
Alexandria, VA 22313**

By FAX: **(571) 273-8300
Attn: Office of Petitions**

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries should be directed to the undersigned at (571) 272-3228.



Edward J. Tannouse
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy